

REMARKS

Applicant has reviewed the Office Action of 30 January 2003 and offers the following remarks. Applicant appreciates the telephonic interview with the Examiner on 26 February 2003. The results of that conversation are incorporated within the remarks where appropriate.

Before addressing the merits of the rejection, Applicant takes a moment to describe the present invention. The present invention is directed to a system and method that allows the Network Address Translation (NAT) to be used with media gateways and more particularly to be used with media gateway controllers. Specifically, the use of media gateways and media gateway controllers generates control messages which heretofore have been ineligible for NAT by virtue of the fact that the IP addresses embedded in the control messages are not subjected to NAT. The present invention offers two techniques by which the control messages may be inspected and translated. The first technique places the NAT intelligence in the firewall or router that handles the control messages. The second technique routes all of the control messages to a server that handles the NAT intelligence.

Claims 1-4 and 7-10 were rejected under 35 U.S.C. § 103 as being unpatentable over Zhang et al. in view of Cave et al. Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where each and every element of the claims are located in the references. MPEP § 2143.03. Further, the Patent Office must offer a motivation for a particular combination of references. In the present case, the Patent Office opines that Zhang et al. shows the translation function and structures that perform this translation as recited in claim 1. Further, the Patent Office admits that the Zhang et al. reference does not specify that this translation would be performed on the claimed control messages. The Patent Office then opines that control messages are well known in the art and it would have been obvious to modify the system disclosed by Zhang et al. as evidenced by Cave et al. The Patent Office specifically opines that "a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Zhang et al. by employing the use of control messages."

The combination of Zhang et al. with the control messages of Cave et al. does not render the claimed invention obvious. As discussed in the interview, if Zhang et al. and Cave et al. are combined, the combination that results shows performing NAT on some messages and having

control messages that are ineligible for NAT because the IP addresses embedded in the control messages are not subjected to NAT. This is exactly the situation that was criticized in Applicant's background. In contrast, Applicant claims receiving a control protocol message from a node on a first IP network; translating the IP address within the control protocol message to an IP address associated with the second IP network; and routing the control protocol message to the node on the second IP network. This specifically claims translating the IP address within the control protocol message. The combination of references does not show the claimed invention. The combination must be modified to show the claimed the invention. To paraphrase the interview, the combination shows "doing x" and "doing y" not "doing x on y." While Examiner indicated that such a motivation could perhaps be articulated, the Patent Office has, to date, offered no motivation as to how or why the combination should be modified to arrive at the claimed invention. Applicant is not obligated to create arguments for the Patent Office or fill in the gaps in the Patent Office's position, and thus, can only respond to the rejection and rationale of record. The rejection of record provides no motivation to modify the combination to render the claimed invention obvious. Since the Patent Office has not provided the requisite motivation to modify the combination to arrive at the claimed invention, the claimed invention is not shown, and the Patent Office has not established *prima facie* obviousness. Since the Patent Office has not established *prima facie* obviousness, the claims are allowable over the rejection of record.

Claims 2-4 depend from claim 1 and are patentable at least for the same reasons that claim 1 is patentable.

Claim 7, although a method claim, was rejected for essentially the same reason that claim 1 was rejected. Just as the combination offered by the Patent Office for claim 1 does not show the claimed invention, the combination offered by the Patent Office for claim 7 does not show the claimed invention without further modification for which the Patent Office has provided no motivation. Since the Patent Office has not provided a motivation for the modification, the claimed invention is not shown by the combination, and the claim is allowable over the rejection of record.

Claim 8 depends from claim 7 and is patentable at least for the same reasons that claim 7 is patentable.

Claim 9, although a software claim, was rejected for essentially the same reason that claim 1 was rejected. Just as the combination offered by the Patent Office for claim 1 does not

show the claimed invention, the combination offered by the Patent Office for claim 9 does not show the claimed invention without further modification for which the Patent Office has provided no motivation. Since the Patent Office has not provided a motivation for the modification, the claimed invention is not shown by the combination, and the claim is allowable over the rejection of record.

Claim 10 depends from claim 9 and is patentable at least for the same reasons that claim 9 is patentable.

Claims 5, 6, and 11-16 were rejected as being unpatentable over Zhang et al. in view of Cave et al. and Arrow et al. Applicant respectfully traverses. This rejection relies on the same flawed combination of Zhang et al. and Cave et al. addressed above. Nothing in Arrow et al. cures the problems with the underlying combination. Since the Patent Office has not shown all of the claim elements, the claims are allowable over the rejection of record.

Claim 5 deserves special mention. Specifically, claim 5 recites a port having an IP address. The Patent Office opines that Figure 4 of Zhang et al. teaches the recited port. Applicant specifically traverses this assertion. Applicant has studied Figure 4 and the supporting text and finds no reference to a port of any sort. Applicant appreciates the Examiner's explanation that "port" is a term that may be construed broadly, but the Patent Office still must explain how the reference teaches a port under a broad interpretation. If the Patent Office maintains that the port is inherent, the Patent Office must show that the element necessarily is present in the reference. MPEP § 2112. If the Patent Office points to a new portion of the reference and explains how that portion of the reference teaches a port, then Applicant reserves the right to address this new citation in the next response. Again, Applicant is not obligated to create the arguments for the Patent Office and can only respond to the rejection and rationales offered by the Patent Office. Nothing in the remaining references provides the missing port. Since none of the references individually supply the missing element, even in combination, the references cannot supply the missing element. Since there is a claim element that is not shown or suggested by the combination, the Patent Office has failed to establish *prima facie* obviousness. MPEP § 2143.03. Thus, the claim is allowable over the rejection of record.

The Patent Office further opines that Arrow et al. teaches that the firewall performs the translating, and references Figure 8 (see Office Action, page 9, lines 10-12). Later in the rejection, the Patent Office points out that in Figure 8, the translation occurs in box 808, which is

distinct from the firewall 806 (see Office Action, page 11, last 2 lines). As discussed in the telephonic interview, the Patent Office cannot have it both ways. Either the reference in Figure 8 teaches that the translation occurs in the firewall 806 or in the translation unit 808, but the cited passage does not teach both concepts. Applicant maintains that the firewall of the reference does not perform any translation, and thus, the Patent Office's reliance on Arrow et al. for this claim element is misplaced. Since the Patent Office admits that the other references do not teach or suggest this element, and Arrow et al. does not teach or suggest this element individually, even in combination, the references cannot teach or suggest the claim element. This provides an independent reason why the Patent Office has failed to establish *prima facie* obviousness for claim 5.

Claim 6 depends from claim 5 and is allowable at least for the same reasons that claim 5 is allowable.

Claims 11, 13, and 15 also deserve special mention. Each of these claims recites effectively that the server is positioned within the network, behind the firewall. For example, claim 11 recites that the server returns the translated control protocol messages to the firewall and that the firewall routes the messages to a node on a second IP network. This necessarily means that the server is within the firewall. Claim 13 recites that the firewall of the first network receives the message and routes it to the server, and then the server routes the message to a node on the first network. Again, this necessarily means that the server is inside the firewall. Claim 15 is closely analogous to claim 13. In contrast, as Figure 8 makes abundantly clear and the Patent Office admitted during the telephonic interview, the translation box 808 is outside the local network and outside the firewall. Because the translation box 808 is outside the firewall, it cannot teach or suggest the recited claim elements which require that the server be inside the firewall. To this extent, Arrow et al. does not teach or suggest a claim element. The Patent Office has admitted that the other two references do not teach or suggest the claim element in question. Since none of the references individually teach or suggest the claim element, even combined, the references cannot teach or suggest the claim element. Since the claim element is not taught or suggested by the combination, the Patent Office has failed to establish *prima facie* obviousness, and the claims are allowable over the rejection of record.

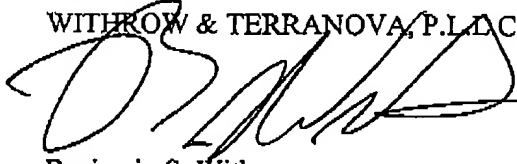
Claims 17 and 18 have been added. Support for these claims can be found at page 8, lines 9-15 of the specification. These claim specific actions by the firewall that are taken that are clearly not shown by the references of record.

Applicant appreciates the thorough review that has been performed in the examination of these claims, but as argued above, the combination of references does not show the claimed invention. The combination requires further modifications for which the Patent Office has provided no motivation and/or the combination does not show all of the claimed elements. For these reasons, Applicant requests reconsideration of the rejection and claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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